

REMARKS

Summary of the Final Office Action

In the Final Office Action, claims 1-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the previously-applied U.S. Patent No. 5,881,032 to Ito et al. (hereinafter "Ito") in view of the previously-applied U.S. Patent No. 6,128,272 to Horimai et al. (hereinafter "Horimai").

Claims 22-23 and 25, which were newly-added in the Amendment filed on August 6, 2004, stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

Summary of the Response to the Final Office Action

Applicant has amended claims 1-2, 5-9, 11 and 13-17 to differently describe embodiments of the invention and to improve the form of the claims. Claims 3 and 4 are canceled without prejudice or disclaimer. Accordingly, claims 1-2 and 5-26 remain pending for consideration.

The Rejections under 35 U.S.C. § 112, First Paragraph

Claims 22-23 and 25, which were newly-added in the Amendment filed on August 6, 2004, stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

In this regard, the Final Office Action states that the feature "physical addresses in a land track are allocated **discontinuously** from physical addresses in a groove track in each of the recording layers" in claims 22-23 and 25 is not described in the specification.

Applicant respectfully submits however, that this assertion is incorrect for at least the following reasons. For example, Figs. 1, 4 and 5 of the instant application clearly illustrate that physical addresses on a land track on a recording layer are allocated discontinuously from physical addresses on a groove track on the recording layer. This feature is also clearly described, for example, at lines 12-20 on page 18, lines 8-13 on page 24, and lines 1-21 on page 28 of the instant application's specification. For example, in FIG. 4, a first recording layer 11 has a land track 11B and a groove track 11A. Further, a second recording layer 12 has a land track 12B and a groove track 12A. Physical addresses are provided in the order of: the land track 11B on the first recording layer 11; the groove track 12A on the second recording layer 12; the groove track 11A on the first recording layer 11; and the land track 12B on the second recording layer 12. Accordingly, it is clear that the land track on one recording layer has physical addresses which are discontinuous from physical addresses on the groove track on said one recording layer. For at least the foregoing reasons, Applicant respectfully submits that the feature "physical addresses in a land track are allocated discontinuously from physical addresses in a groove track in each of the recording layers" of claims 22-23 and 25 is clearly described in the specification and drawings of the instant application. As a result, withdrawal of the rejection under 35 U.S.C. § 112 first paragraph is respectfully requested.

The Rejections under 35 U.S.C. § 103(a)

Claims 1-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the previously-applied Ito in view of the previously-applied Horimai. Applicant has newly-amended the claims by deleting "to be" from claims. Moreover, features of previous claim 3 have been

added to claim 1, and features of previous claim 4 have been added to claim 2. Accordingly, claims 3 and 4 have been canceled without prejudice or disclaimer. Withdrawal of the outstanding rejections under 35 U.S.C. § 103(a) is thus respectfully requested for at least the following reasons.

The Final Office Action alleges that the features of claims 3 and 4, which have now been incorporated into newly-amended independent claims 1 and 2, respectively, are rejected under 35 U.S.C. § 103(a) because the Office Action's proposed combination of Ito and Horimai would show all of the features of these claims. This interpretation is respectfully traversed for at least the following reasons.

The Final Office Action refers to col. 8, line 26 to col. 9, line 18, Figs. 1-4 of Ito and Ito's alleged teaching of "contiguous recording/reproduction of the tracks "grooves/lands." However, Applicant respectfully submits that the features of previous claims 3 and 4, which have now been incorporated into newly-amended independent claims 1 and 2, respectively, are not disclosed, taught, or suggested not only in the portions of Ito which the Final Office Action cites to, but also are not disclosed in any other portions of Ito's disclosure.

For example, at lines 45-48 of col. 8, Ito discloses "it is also possible for the information reproducing apparatus to create contiguous logical space spanning plural recording layers (emphasis added)." Moreover, at lines 49-51 of col. 8, Ito discloses "it is possible to provide at low cost and high performance information reproducing apparatus capable of contiguously reproducing data from plural recording layers (emphasis added)." At lines 60-62 of col. 8, Ito discloses "FIG. 1A shows the spiral groove pattern on the first layer L1, FIG. 1B shows the

spiral groove pattern on the second layer L2 (emphasis added)." At lines 11-13 of col. 9, Ito discloses "a contiguous logical space at the outer (or inner) most sector address of the first layer and that of the second layer can be obtained (emphasis added)." Further, at lines 57-59 of col. 9, Ito discloses "the data recording grooves are formed to enable contiguous reproduction from the first to the second layer (emphasis added)." At lines 41-42 of col. 12, Ito discloses "(2) Convert the sector addresses to a contiguous logical space across plural layers (emphasis added)." At lines 52-54 of col. 14, Ito discloses "becomes a contiguous address value starting from 0 in the white region bounded by the shaded areas in the first and second layers (emphasis added)." As explained above, Applicant respectfully submits that Ito merely teaches a contiguous address is provided on groove tracks across layers.

On the other hand, independent claims 1 and 2 have been newly-amended to include features of original claims 3 and 4, respectively, in that "third information subsequent to said second information is recorded on one of the land track and the groove track of said first recording layer on which said first information is not recorded, and fourth information subsequent to said third information is recorded on one of the land track and the groove track of said second recording layer on which said second information is not recorded."

As a result, if said first information is recorded on a groove track of said first recording layer and second information subsequent to said first information is recorded on a groove track of said second layer, said third information subsequent to said second information is recorded on a land track of said first recording layer and said fourth information subsequent to said third information is recorded on a land track of said second recording layer, as shown, for example, in

Fig. 1 of the instant application. Applicant respectfully submits that this kind of specific recording manner or data recording structure using both a land track and a groove track across a plurality of recording layers is not disclosed, taught, or suggested in any of the references of record.

Applicant respectfully submits that Horimai is silent about a plurality of recording layers, and Ito is silent about a recording manner or data recording structure using both a land track and a groove track. Ito merely teaches a way of data recording only using groove tracks across a plurality of recording layers. Therefore, it is Applicant's position that even assuming, strictly arguendo, that a person skilled in the relevant art was to combine Horimai and Ito in the manner suggested by the Final Office Action, he could not obtain the specific features recited in the combinations of independent claims 1 and 2, as newly-amended.

In particular, each of newly-amended independent claims 1 and 2 recites specific features of previous claims 3 and 4 in that information recorded on the land track and the groove track of one recording layer is not reproduced sequentially. For example, after reproducing information recorded on a groove track of one recording layer, information recorded on a groove track of the other recording layer is reproduced. Then, reproducing is conducted on the first of these recording layers again. That is, after reproducing the information recorded on the groove track of the other recording layer, information recorded on a land track of the first of these recording layers is reproduced. Further, after reproducing the information recorded on the land track of the first of these recording layers, information recorded on a land track of the other recording layer is reproduced. This specific reproducing operation, which is performed from a recording layer to

another recording layer and then returned to first of these recording layers again and then to the other recording layer again, is not disclosed, taught, or suggested in any of the references of record. As a result, Applicant respectfully submits that the rejection under 35 U.S.C. § 103(a) of claims 1-17 should be withdrawn.

In addition, Applicants respectfully submit that the rejection under 35 U.S.C. § 103(a) of claims 18-21 should be withdrawn for similar reasons as discussed above and because no references of record disclose, teach, or suggest a device which performs the above-explained reproducing operations.

The Final Office Action also alleges that Ito shows the "physical addresses in a land track are allocated discontinuously from physical addresses in a groove track in each of the recording layers" features of claims 22-23 and 25 at col. 9, line 35 - col. 10, line 49, and Figs. 2 and 4. Applicant respectfully traverses this interpretation for at least the following reasons.

As explained in the foregoing discussion, Ito includes no description of a "land track" relating to a groove track. Instead, Ito utilizes only groove tracks across a plurality of recording layers. Applicant respectfully submits that Ito does not teach, or even suggest, the features of claims 22-23 and 25 of a "physical addresses in a land track are allocated discontinuously from physical addresses in a groove track in each of the recording layers" to any extent. Accordingly, the rejection under 35 U.S.C. § 103(a) of claims 22 and 23 should be withdrawn. In addition, the rejection under 35 U.S.C. § 103(a) of claims 24-26 should be withdrawn because no references of record disclose, teach, or suggest a device which performs a reproducing operation in accordance with the above-discussed specific data recording structure. Consequently, all of the

rejections should be withdrawn.

Applicant respectfully asserts that the rejections under 35 U.S.C. § 103(a) should be withdrawn because neither Ito nor Horimai, whether taken singly or combined, teach or suggest each feature of independent claims 1 and 2, as amended, and independent claims 17-22 and 24-26. MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)." Furthermore, Applicant respectfully asserts that dependent claims 5-16 and 23 are allowable at least because of their dependence from claims 1, 2 or 22, and the reasons set forth above.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests the entry of this Amendment to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite the prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required,

including any required extension of time fees, or credit any overpayment to Deposit Account

50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR**

EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted

MORGAN, LEWIS & BOCKIUS LLP

By:



Paul A. Fournier

Reg. No. 41,023

Dated: March 24, 2005

Customer Number 009629

MORGAN, LEWIS & BOCKIUS LLP

1111 Pennsylvania Avenue, N.W.

Washington, DC 20004

202-739-3000